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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/392,678	09/09/1999	STEVEN M. DRUCKER	1026-012/MMM	1607

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IPSOLON LLP
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EXAMINER

JONES, HUGH M

ART UNIT	PAPER NUMBER
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2123

DATE MAILED: 07/30/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/392,678

Applicant(s)
Drucker et al.

Examiner
Hugh Jones

Art Unit
2123



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 9, 1999
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

1. Claims 1-21 of U.S. Application 09/392,678 filed 9/9/1999 are pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 1-7, 15-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.** These claims appear to recite a computer program product. It should be noted that code (i.e., a computer software program) does not do anything per se. Instead, it is the code stored on a computer that, *when executed*, instructs the computer to perform various functions. The following claim is a generic example of a proper computer program product claim;

A computer program product embodied on a computer-readable medium and comprising code that, when executed, causes a computer to perform the following:

Function A

Function B

Function C, etc...

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Claim Interpretation

4. The broadest, most reasonable interpretation has been provided to the claims. The invention appears to be an interactive "Prisoner's Dilemma" game played over the internet.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or

unobviousness.

7. **Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over (Grobelnik et al. *or* "Noise-IPD Game Contest" *or* Brown) in view of (Honda et al. *or* Saar).**

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8. Groblenik et al. disclose "Strategic interaction on the internet," including playing Social Dilemma games on the internet (sections I-II).
9. "Noise-IPD Game Contest" disclose rules for a contest to develop interactive social dilemma games, including "Prisoner's Dilemma). See pages 1-6.
10. Brown disclose a multi-player on-line interactive gaming environment including "Prisoner's Dilemma". See fig. 6-7; col. 5, line 61 to col. 8, line 10.
11. Groblenik et al. or "Noise-IPD Game Contest" or Brown teach all limitations and features as discussed, but do not disclose playing the game via a multi-user virtual society.
12. Honda et al. disclose "Virtual Society: extending the WWW to support a multi-user interactive shared 3D environment," including fig. 1 (server-client relation between WWW and Virtual Society); section 3 (Virtual Society architecture); and section 4 (protocol).
13. Saar disclose "VIRTUS: a collaborative multi-user platform," including objects and collaborative virtual environment and distributed virtual environments. See abstract; section 2.1 (application to interactive gaming); section 4 (VIRTUS architecture);
14. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of *Honda et al. or Saar* into the teachings of Groblenik et al. or "Noise-IPD Game Contest" or Brown for the following reasons. Honda et al. disclose that a virtual society model is a natural extension of the WWW and VRML browsers and that users and service providers will benefit from the more natural interaction (pg. 109, Honda et al.). Saar

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discloses that the shared multi-user worlds would provide added benefits (collaborative pursuits) over the solitary WWW world (page 141).

Response to Arguments (paper # 8)

15. Applicant's arguments, filed 7/14/2003 have been carefully considered and are not found wholly persuasive.

Response to Arguments - Priority (page 6, paper # 8)

16. Applicant's arguments, filed 7/14/2003 have been carefully considered. The Examiner has reviewed the sections of the Provisional Application as directed by Applicants. The Examiner, respectfully, does not find support for the argued features in those sections. However, the Examiner notes that other sections of the Provisional Application do provide support, namely, numbered page 3 of the paper entitled "The Commons: A Toolkit for the Quantitative Analysis of Factors in the Success or Failure of Electronic Societies." Therefore, the issues relating to priority are resolved.

Response to Arguments - IDS (pp. 6-7, paper # 8)

17. Applicant's arguments, filed 7/14/2003 relating to the IDS have been carefully considered and are found persuasive.

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Response to Arguments - 101 Rejections (page 7, paper # 8)

18. Applicant's arguments, filed 7/14/2003 have been carefully considered and are found non-persuasive. Until the program is executed by the computer, it is not structurally and functionally connected to anything.

Response to Arguments - 112 Rejections (pp. 7-8, paper # 8)

19. Applicant's arguments, filed 7/14/2003 have been carefully considered and are found persuasive. Applicants are correct in this reasoning. The 112(1) rejections are withdrawn against the instant application. In any case, there is support in the Provisional Application for the material.

Response to Arguments - 103 Rejections (pp. 8-13, paper # 8)

20. Applicant's arguments, filed 7/14/2003 have been carefully considered and are found non-persuasive.

21. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the recited material from the specification - see pages 9, 12, paper # 8; "the purpose or benefits") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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22. In response to applicant's argument that the art is not used for the same purpose, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

23. In response to applicant's allegation that the art does not disclose "the purpose or benefits", even a recitation (the purpose or benefits have not yet been claimed) of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

24. Applicant's arguments (second full paragraph, page 10, paper # 8) are conclusory and will not be addressed because Applicants have provided any rationale for their position.

Conclusion

25. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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26. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

27. Any inquiry concerning this communication or earlier communications from the examiner should be:

directed to:

Dr. Hugh Jones telephone number (703) 305-0023, Monday-Thursday 0830 to 0700 ET, *or* the examiner's supervisor, Kevin Teska, telephone number (703) 305-9704. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, telephone number (703) 305-3900.

mailed to:


Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051 (for formal communications intended for entry)

or (703) 308-1396 (for informal or draft communications, please label "PROPOSED" or "DRAFT").

Dr. Hugh Jones
Primary Patent Examiner
July 29, 2003


HUGH JONES Ph.D.
PRIMARY PATENT EXAMINER
TECHNOLOGY CENTER 2100